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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/987,775 12/09/97 GREFENSTEIN

A 47587/48070

EXAMINER

IM22/0518

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KRUER, K

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

05/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

08/987,775

Applicant(s)

Grefenstein et al

Examiner

Kevin Kruer

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED May 9, 2001

FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: see attached

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: NONE
- Claim(s) objected to: NONE
- Claim(s) rejected: 24-38
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☒ Other: PTO-892

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ADVISORY ACTION

1. Applicant's arguments filed May 9, 2001 have been fully considered but they are not persuasive. Applicants' proposed amendments to the claims will not be entered because they do not place the claims in better form for appeal by materially reducing or simplifying the issues for appeal, they would require further consideration and/or search. Specifically, the proposed Markush groups of claims 27 and 28 are not proper in accordance with MPEP 2173.05(h). Furthermore, proposed claim 28 requires that the interlayer must comprise a colorant. This limitation has not been previously claimed, and would require further search and/or consideration.

With respect to the applied art, Applicant argues that the method of making the product (i.e., (co)extrusion) inherently results in a product that is materially different from the product taught in Ellison. Specifically, Applicant argues that coextrusion inherently results in some molecular orientation whereas a cast film is inherently unoriented. The examiner disagrees, and maintains the position that an extruded film may be unoriented. Arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964). For example, in a case where the record consisted substantially of arguments and opinions of applicant's attorney, the court indicated that factual affidavits could have provided important evidence on the issue of enablement. See *In re Knowlton*, 500 F.2d at 572, 183 USPQ at 37, and *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). The examiner is

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supplying applicant with US4,467,969 and US4,420,451; both of which teach that extruded films may be unoriented.

In arguendo applicant's claims are limited to films which are oriented, the examiner takes the position that the laminates taught in Ellison are oriented. Specifically, the substrate is molded (col 5, line 32). The partial translation supplied by applicant states that all molded polymers have some degree of orientation (see the bottom of page 11, Paper #11). Furthermore, the decorative surface is heated (aka melted) (col 6, lines 53-57) or molded (col 6, line 56). The partial translation supplied by applicant states that all melted polymers have some degree of orientation (see the bottom of page 11, Paper #11). The decorative film also may be stretched and elongated (col 6, lines 63 and 64)-both processes resulting in orientation of the film. Thus, applicant's arguments are not persuasive.

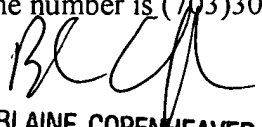
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is (703) 305-0025. The examiner can normally be reached on Monday-Friday from 7:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703)305-5436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0651.

Kevin R. Kruer, Patent Examiner



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